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EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 11/15/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/761,331

Applicant(s)

RODERICK ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/19/02
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-31, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-31, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. Claims 17, 32 and 33 have been cancelled in the amendment received on 09/26/2002.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, and 15-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sandt (US 5,858,493). Sandt discloses a hollow fence pole made of two concentric sleeves and separated by a space filled with a solid reactive resin reinforced with the fibers (figure 10, column 1, lines 51-54). Sandt discloses the sleeves made from polyvinyl chloride (column 4, lines 1-4). Sandt discloses the solid reactive resin being polyester, epoxy, phenolic or urea resin (column 4, lines 61-65). Sandt does not disclose the pole being produced by a coextrusion process. However, the pole of Sandt is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles use the same

Art Unit: 1771

materials, having structural similarity (outer layer/core/inner layer). Even though product-by-process claims are limited by and defined by the process, **determination of patentability is based on the product itself.** The patentability of a product does **not** depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). The Sandt reference either anticipates or strongly suggests the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Sandt.

With regard to claim 6, Sandt teaches the pole having a rectangular cross-section perpendicular to the length (column 3, lines 46-50).

With regard to claim 16, Sandt discloses the structural member being useful as a fence pole (column 1, lines 34-38).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1771

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11-14, 18-25, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandt (US 5,858,493) as applied to claim 1 above, in view of Finley (US 6,054,207). Sandt does not specially disclose the wood fiber as a reinforcing filler of the core. Finley rectifies the missing feature. The summary table of Finley shows that the amounts of wood fiber added to the composite meeting the specific ranges required by the claims (Applicant's specification discloses that the ASA/filler compositions are described in US 6,133,349 (page 9, lines 29-32) and US 6,133,349 teaches a wood component used in an amount of about 1 to 40 weight % (column 6, lines 59-63). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the wood fiber as the reinforcing filler for the core of Sandt motivated by the desire to obtain a high strength composite that is easily manufactured. See product-by-process rationale for co-extrusion process limitations in paragraph no. 4 with respect to claim 1 above.

With regard to claims 12, 22, Sandt does not disclose the foamed core. Finley discloses the thermoplastic polymer of the core can be foamed (abstract and column 8, lines 25-38). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a wood fiber reinforced foam as the core of Sandt motivated by the desire to obtain a

Art Unit: 1771

composite that is thermally stable and has high modulus strength and adequate fastener retention.

With regard to claims 23 and 24, Sandt discloses the structural member being useful as a fence pole (column 1, lines 34-38).

With regard to claim 25, Sandt is silent as to the hollow pole being useful as a decking plank. Finley discloses the structural member having properties sufficient for use as decking (column 12, line 16). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the hollow pole in Sandt being a decking plank since it has structural properties sufficient for use as decking.

With regard to newly added claim 34, Sandt teaches the sleeve being made of polyvinyl chloride (column 4, lines 1-4).

7. Claims 11-14, 18-25, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandt (US 5,858,493) as applied to claim 1 above, in view of Stucky et al (US 6,344,268). Sandt does not specially disclose the wood fiber as a reinforcing filler of the core. Stucky rectifies the missing feature. Stucky teaches a composite for use in decking, fencing and pilings comprising wood flour in an amount of 68 weight % (table 1, and column 3, lines 6-22). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the wood flour as the reinforcing filler for the core of Sandt motivated by the desire to provide better strength. See product-by-process

rational for co-extrusion process limitations in paragraph no. 4 with respect to claim 1 above.

With regard to claims 12, 22, Sandt does not disclose the foamed core. Stucky discloses the thermoplastic polymer of the composite can be foamed (abstract). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a wood fiber reinforced foam as the core of Sandt motivated by the desire to obtain a composite that is thermally stable and has high modulus strength and adequate fastener retention.

With regard to claims 23 and 24, Sandt discloses the structural member being useful as a fence pole (column 1, lines 34-38).

With regard to claim 25, Sandt is silent as to the hollow pole being useful as a decking plank. Stucky discloses a foam composite having been use in decking, fencing and pilings (column 3, lines 6-22). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the hollow pole as a decking plank because it has structural properties sufficient for use as decking.

With regard to newly added claim 34, Sandt teaches the sleeve being made of polyvinyl chloride (column 4, lines 1-4).

8. Claims 26-31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandt (US 5,858,493) in view of Finley (US 6,054,207) and further in view of Kennedy et al (US 4,964,618). The combination of the primary and secondary references teaches every element in the claims except a construction of a

fencing system (see discussion in claims 1 and 18). Kennedy discloses a fence system comprising a plurality of fence posts **22** attached to a plurality of fence rails **24** (figure 1). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the hollow pole of Sandt as modified by Finley in the construction of the claimed fence system since it is a typical design of the fencing system. See product-by-process rational for co-extrusion process limitations in paragraph no. 4 with respect to claim 1 above. With regard to newly added claim 35, Sandt teaches the sleeve being made of polyvinyl chloride (column 4, lines 1-4).

9. Claims 26-31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandt (US 5,858,493) in view of Stucky et al (US 6,344,268) and further in view of Kennedy et al (US 4,964,618). The combination of the primary and secondary references teaches every element in the claims except a construction of a fencing system (see discussion in claims 1 and 18). Kennedy discloses a fence system comprising a plurality of fence posts **22** attached to a plurality of fence rails **24** (figure 1). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the hollow pole of Sandt as modified by Stucky in the construction of the claimed fence system since it is a typical design of the fencing system. See product-by-process rational for co-extrusion process limitations in paragraph no. 4 with respect to claim 1 above.



With regard to newly added claim 35, Sandt teaches the sleeve being made of polyvinyl chloride (column 4, lines 1-4).

***Response to Arguments***

10. The art rejections have been overcome by the present amendment and response.
11. Applicant's arguments with respect to claims 1-16, and 18-31 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



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